

REMARKS

Applicant has amended claim 23 to more appropriately define the present invention.

Claims 14-27 are pending, with claims 14-22 withdrawn from further consideration as drawn to a nonelected invention, and claims 23-27 under current examination.

Regarding the Office Action:

In the Office Action, the Examiner required affirmation of Applicant's oral election in a Restriction Requirement, and rejected claims 23-27 under 35 U.S.C. § 102(b) as anticipated by Shibata, et al. (U.S. Patent No. 5,371,373) ("Shibata"). Applicant traverses the rejection for the following reasons.¹

Regarding the Claim Amendments:

Support for the amendments to claim 23 may be found in the specification at, for example, Figs. 10B, 16A, and 16B, and their corresponding description.

Regarding the Restriction Requirement:

Applicant affirms the oral election to prosecute Group III, claims 23-27, characterized by the Examiner as "drawn to charge particle beam method" (Office Action, p. 2), without traverse.

Rejection of Claims 23-27 under 35 U.S.C. § 102(b):

In order to properly establish that Shibata anticipates Applicant's claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the

¹ The Office Action contains statements characterizing the related art, case law, and the claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

... claim.” See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Shibata does not disclose each and every element of Applicant’s claimed invention, despite the Examiner’s allegations. Independent claim 23, as amended, recites, among other things, “...dividing layout data of a semiconductor apparatus into sizes smaller than basic figure apertures... and emitting a beam onto a sample, the beam being shaped into a form of an overlapped portion of the divided layouts and a part of the classified basic figure apertures.”

In contrast to the claimed invention, Shibata’s Fig. 8 shows cell projection unit areas 39 and 40. The whole of cell projection unit areas 39 and 40 are arranged to compose the layout of the semiconductor device. Moreover, the outline of the pattern irradiated to the substrate is the same size as the cell projection unit areas 39 and 40. Thus, it is clear that Shibata does not teach “dividing layout data of a semiconductor apparatus into sizes *smaller than* basic figure apertures,” as recited in claim 23 (italics added).

As such, Shibata does not disclose each and every element of claim 23. Shibata therefore does not anticipate Applicant’s claims 23-27, and the Examiner has not met these essential requirements of anticipation for a proper 35 U.S.C. § 102(b) rejection. Independent claim 23 is allowable, for at least the reasons set forth above, and dependent claims 24-27 are also allowable at least by virtue of their dependence from allowable base claim 23. Therefore, the improper 35 U.S.C. § 102(b) rejection of claims 23-27 should be withdrawn.

Conclusion:

In view of the foregoing, Applicant requests reconsideration of the application and withdrawal of the rejection. Pending claims 23-27 are in condition for allowance, and Applicant requests a favorable action.

Should the Examiner continue to dispute the patentability of the claims after consideration of this Amendment, Applicant encourages the Examiner to contact the undersigned representative by telephone to discuss any remaining issues or to resolve any misunderstandings.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 27, 2004

By: 
David M. Longo
Reg. No. 53,235

/direct telephone: (202) 408-4489/